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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,988	12/28/1999	TERUAKI OKUDA	35.G2524	9448
5514	7590	01/12/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SCHWARTZ, PAMELA R	
		ART UNIT	PAPER NUMBER	
		1774	23	

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/472,988	OKUDA, TERUAKI
	Examiner Pamela R. Schwartz	Art Unit 1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 4,5 and 7-11 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,6 and 12-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

1. The restriction requirement was made final in Paper No. 18.

2. Claims 1-3, 6 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Hirose et al. (6,203,899) taken alone or in view of either of Malhotra (6,180,238) or Cousin et al. (4,554,181) for reasons of record and for reasons given below. With respect to claim 12, see col. 7, lines 38-57 of the primary reference. With respect to claim 13, as stated by MPEP 2111.03, "consisting essentially of" language limits the scope of the claim to specified materials and materials that do not materially affect the basic and novel characteristics of the invention. However, applicants have the burden of showing that the additional components would materially change the basic and novel characteristics of their invention. So far, they have not met this burden.

Contrary to applicants' arguments, the outer layer of the primary reference may be two-thirds resin particles (see column 4). The examiner is relying upon this disclosure for purposes of the rejection rather than a different embodiment in which the surface layer may have little or no binder. The examiner does not believe that inherency requires every embodiment disclosed by a reference to meet the relevant limitation, but

rather than the embodiment relied upon in formulating the rejection inherently meet the claim limitation.

3. Applicant's arguments filed September 22, 2003 and made at the interview of October 8, 2003 have been fully considered but they are not persuasive. As explained in the final rejection, the ratio of particles to binder in the surface layer of the reference is 50:1 to 1:2. Therefore, the layer may contain twice as much binder as pigment. Similar layers taught in the prior art are transparent. For example, in 6,214,458 to Kobayashi et al., a transparent layer (see col. 2, lines 33-35) is disclosed as containing agglomerated silica (primary particle size of less than 10 nm) of particle size between 10 and 100 nm, and has a ratio of silica to resin of from 1.5:1 to 10:1 (see col. 15, lines 34-54). This range overlaps considerably with that of Hirose et al. and demonstrates that transparent surface layers are disclosed by Hirose et al.

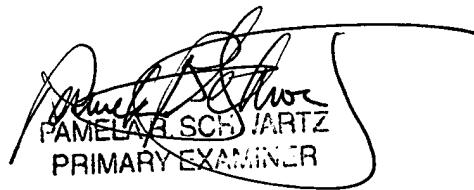
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose telephone number is 571-272-1528. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.

PRSchwartz

January 8, 2004



PAMELA B. SCHWARTZ
PRIMARY EXAMINER